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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,566	01/31/2004	Frank Hartung	PI9071-US1	8900
27045	7590	01/25/2008		
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024			EXAMINER LAZARO, DAVID R	
			ART UNIT 2155	PAPER NUMBER
			MAIL DATE 01/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/769,566

Applicant(s)

HARTUNG ET AL.

Examiner

David Lazaro

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/31/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-50 are pending in this office action.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 01/3¹~~4~~/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Oath/Declaration

3. The signed oath/declaration responsive to pre-exam formalities was received 08/11/2004.

Drawings

4. The drawings are objected to because part of the labeling of item 214 in Figure 2 is not legible. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10, 47-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Regarding claims 1, the phrase "like" (lines 1-2) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
8. Claims 1-10 are directed towards a "transcoding proxy" which seems to indicate the statutory category of a machine. However, the claim language only indicates functional steps and does not include any subject matter directed towards the structural or material limitations of a "transcoding proxy". As such, it is not clear as to how the "transcoding proxy" is a machine in relation to the claimed subject matter. Claims 2-10

ultimately depend on claim 1. Because the invention has not been distinctly claimed, claims 1-10 are indefinite.

9. Claims 47 and 49 are both directed to a device. However, the claim language only states "A device **capable of**" (emphasis added). As such, the limitations following this language only describe the intended use (i.e. lacking patentable weight) and do not distinctly claim the elements that make up applicant's invention in relation to the device embodiment. Particularly, as the limitations only describe the intended use, it is not clear as to what elements or structures make up the claimed device. In other words, the preamble sets forth a device, but the body of the claim does not indicate how the preamble is met. Note that claims 48 and 50 depend on claim 47 and 49 respectively. For these reasons, claims 47-50 are indefinite.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 6, 9, 11, 16, 18, 47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,963,972 by Chang et al. (Chang).

12. With respect to claims 1, 11, 47 and 49, Chang teaches a transcoding proxy capable of transcoding encrypted content, like an encrypted multimedia message or a multimedia message containing encrypted elements parts, transmitted between two devices by performing the following steps:

receiving an encrypted multimedia message from a first device (Col. 7 lines 39-58 and Fig. 8: encrypted content is received);

requesting and receiving a message which enables the performance of the following steps (Col. 2 lines 29-44 and Col. 7 lines 39-58: in order to decrypt, proxy must possess a key which it gets from either the source or destination device):

decrypting the encrypted multimedia message (Col. 7 lines 39-58 and Fig. 8: content decrypted);

transcoding the decrypted multimedia message so the multimedia message matches the capabilities of second device and can be accessed by a user of said second device (Col. 7 lines 39-58 and Fig. 8 content is transcoded into format adapted for the receiving device); and

re-encrypting the transcoded multimedia message (Col. 7 lines 39-58 and Fig. 8: transcoded content is re-encrypted); and

sending the re-encrypted transcoded multimedia message to the second device (Col. 7 lines 39-58 and Fig. 8: re-encrypted content is sent).

13. With respect to claims 6, 16, Chang further teaches wherein said multimedia message is one or any combination of text, image, audio or video (Col. 6 lines 28-35).

14. With respect to claims 9, 18, Chang further teaches wherein said encrypted multimedia message includes a multimedia message containing encrypted elements parts (Col. 7 lines 39-58).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 2-5, 7, 8, 10, 12-15, 17, 19-26, 28-40, 42-46, 48 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Applicant's admitted prior art (Paragraph [0005] and Fig. 2).

17. With respect to claims 2, 12, 48 and 50, Chang further teaches that the message is a transcoding rights object (TRO) message that includes at least a key and optional permissions for transcoding the multimedia message (Col. 2 lines 29-44 and Col. 7 lines 39-58: key is required for transcoding, permission implied).

Chang does not explicitly disclose the key is specifically a content encryption key. However, applicant's admitted prior art indicates that a content encryption key is known in the art (Paragraph [0005]).

Because both Chang and Applicant's admitted prior art teach encryption keys used for encrypting and decrypting data, it would have been obvious to one of ordinary

skill in the art to substitute one key for the other to achieve the predictable result of encrypting and decrypting data.

18. With respect to claims 3, 13, Chang further teaches wherein said CEK is an encrypted CEK (Applicant's admitted prior art - paragraph [0005]).

19. With respect to claims 4, 14, Chang further teaches wherein said permission for transcoding the multimedia message is implicit with the provisioning of the CEK (In Chang: Col. 2 lines 29-44 and Col. 7 lines 39-58: key is required for transcoding, permission implied).

20. With respect to claims 5, 15, Chang further teaches a first device and second device (Col. 7 lines 39-58) but does not explicitly disclose the devices as being mobile phones.

However, applicant's admitted prior art indicates that it is well known in the art that a first device can be a mobile phone that is communicating data to a second mobile phone (Paragraph [0005] and Fig. 2).

Because both Chang and applicant's admitted prior art teach the exchange of data between two devices, it would have been obvious to one of ordinary skill in the art to substitute the devices of Chang with the mobile phone devices of the admitted prior art to achieve the predictable result of exchanging data.

21. With respect to claim 7, Chang does not explicitly disclose the transcoding proxy is a Multimedia Messaging Service Center (MMS-C).

However, applicant's admitted prior art indicates that it is well known in the art that a transcoding proxy can be a Multimedia Messaging Service Center (MMS-C) (Paragraph [0003]).

Because Chang and Applicant's admitted prior art both teach transcoding data through a transcoding proxy, it would have been obvious to one of ordinary skill in the art to substitute the transcoding proxy of Chang with the MMS-C transcoding proxy of the admitted prior art for the predictable result of a transcoding proxy that can transcode data.

22. With respect to claim 8, while Chang teaches a trusted proxy (Col. 2 lines 29-44), Chang does not explicitly disclose said transcoding proxy contains an OMA DRM complaint/licensed entity trusted by a rights issuer.

However, applicant's admitted prior shows that it is well known in the art for a transcoding proxy to contain an OMA DRM complaint/licensed entity trusted by a rights issuer (Paragraph [0005]).

It would have been obvious to one of ordinary skill in the art to use the OMA DRM complaint/licensed entity taught by the admitted prior art to use in the trusted proxy disclosed by Chang. Using the known technique of an OMA DRM complaint/licensed entity trusted by a rights issuer as part of the trusted proxy of Chang would have been obvious to one of ordinary skill in the art.

23. With respect to claims 10 and 17, Chang does not explicitly disclose said transcoding proxy is an Open Mobile Alliance's (OMA) Digital Rights Management (DRM) compliant entity and said message is a rights object (RO) message.

However, applicant's admitted prior art show that it is well known in the art for a transcoding proxy to be Open Mobile Alliance's (OMA) Digital Rights Management (DRM) compliant entity and said message is a rights object (RO) message (Paragraph [0005]).

It would have been obvious to one of ordinary skill in the art to have the transcoding proxy be an Open Mobile Alliance's (OMA) Digital Rights Management (DRM) compliant entity and said message be a rights object (RO) message to provide the trusted portion of the trusted proxy of Chang. Using the known technique of an Open Mobile Alliance's (OMA) Digital Rights Management (DRM) compliant entity and said message be a rights object (RO) message as part of the trusted proxy of Chang would have been obvious to one of ordinary skill in the art.

24. With respect to claims 19 and 33, Chang teaches a system for providing a Multimedia Messaging Service (MMS), said system comprising:

a content provider for providing an encrypted multimedia message to a first device (Col. 7 lines 4-10).

providing an encryption key at the first device so that a user said first device can access the encrypted multimedia message (Col. 2 lines 29-44: key is required to access the encrypted content);

a transcoding proxy for receiving an encrypted multimedia message from said first device (Col. 7 lines 39-58);

said transcoding proxy for requesting and receiving a transcoding rights object (TRO) (Col. 2 lines 29-44 and Col. 7 lines 39-58);

said transcoding proxy for using the TRO message to perform the following steps:

decrypting the encrypted multimedia message (Col. 7 lines 39-58);
transcoding the decrypted multimedia message so the multimedia message could be accessed by a user of a second device (Col. 7 lines 39-58); and
re-encrypting the transcoded multimedia message (Col. 7 lines 39-58);
said transcoding proxy for sending the re-encrypted transcoded multimedia message to the second device (Col. 7 lines 39-58); and
for providing a encryption key to said second device so that the user of said second device can access the re- encrypted transcoded multimedia message (Col. 2 lines 29-44 and Col. 7 lines 39-58).

Chang does not explicitly disclose a rights issuer for providing a content encryption key (CEK). Applicant's admitted prior art indicates that it is well known in the art that a rights issuer can provide a content encryption key (CEK) to a device such that the device can access the associated encrypted multimedia message (Paragraph [0005]-[0006]).

It would have been obvious to one of ordinary skill in the art to use the rights issuer of the admitted prior art to provide the encryption key information for the encrypted data of Chang. Using the known technique of a rights issuer providing a content encryption key for giving access to encrypted data as desired by Chang would have been obvious to one of ordinary skill in the art.

25. With respect to claims 20 and 34, Chang further teaches wherein said transcoding proxy is a trusted entity (Col. 2 lines 29-44: trusted proxy).

26. With respect to claims 21 and 35, Chang further teaches wherein said rights issuer can authenticate and authorize said transcoding proxy (Col. 2 lines 29-44: trusted proxy)

27. With respect to claims 22 and 36, Chang further teaches wherein said TRO message includes a content encryption key (CEK) and permission for transcoding the multimedia message (Applicant admitted prior art - paragraph [0005]).

28. With respect to claims 23 and 37, Chang further teaches wherein said CEK is encrypted with a shared secret between said rights issuer and said transcoding proxy (Applicant admitted prior art - paragraph [0005]).

29. With respect to claims 24 and 38, Chang further teaches wherein said CEK is encrypted with a public key associated with said transcoding proxy (Applicant admitted prior art - paragraph [0005]).

30. With respect to claims 25 and 39, Chang further teaches wherein said permission for transcoding the multimedia message is implicit with the provisioning of the CEK (Col. 2 lines 29-44 and Col. 7 lines 39-58).

31. With respect to claims 26 and 40, Chang further teaches said permission for transcoding the multimedia message is expressed by using a Rights Expression Language or a Rights Expression Language Extension or another machine readable signaling (Col. 2 lines 29-44: encryption key which implicitly indicates permissions would read as 'another machine readable signaling').

32. With respect to claims 28 and 42, Chang does not explicitly disclose wherein said transcoding proxy uses an Uniform Resource Locator (URL) of said rights issues to request the TRO message from said rights issuer.

However, applicant's admitted prior art indicates it is well known in the art that a device can use an URL associated with a rights user in order to request a rights object (Paragraph [0006]).

It would have been obvious to one of ordinary skill in the art to use the URL of the rights issuer as taught in the admitted prior art to enable the access to the encrypted information of Chang the encryption key information for the encrypted data of Chang. Using the known technique of an URL associated with a rights user for enabling access to encrypted data as desired by Chang would have been obvious to one of ordinary skill in the art.

33. With respect to claims 29 and 43, Chang further teaches wherein said TRO message is sent from said rights issuer to said transcoding proxy over an unprotected channel (Col. 2 lines 29-44: can be secured or unprotected).

34. With respect to claims 30 and 44, Chang further teaches wherein said TRO message is sent from said rights issuer to said transcoding proxy over a secured channel (Col. 2 lines 29-44: can be secured or unprotected).

35. With respect to claims 31 and 45, Chang further teaches said first device is a mobile phone; and said second device is a mobile phone (Applicant's admitted prior art [0005]).

36. With respect to claims 32 and 46, Chang further teaches wherein said multimedia message is one or any combination of text, image, audio or video (Col. 6 lines 28-35).

37. Claims 27 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Applicant's admitted prior art and in further view of U.S. Patent Application Publication 2002/0169823 by Coulombe et al. (Coulombe).

38. With respect to claims 27 and 41, Chang does not teach said transcoding permission message specifies which transcoding is permitted and whether consecutive transcoding is allowed in said transcoding proxy.

Coulombe teaches a transcoder element which transcodes data based on the permissible transcoding operations authorized by the content creator (Page 2 [0030]). The permissible operations may also be limited to a particular sequence of operations (Page 4 [0063]-[0065]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the transcoding permissions of Coulombe in the trusted proxy of Chang. Using the known technique of transcoding permissions for protecting the encrypted multimedia content of Chang would have been obvious to one of ordinary skill in the art.

Conclusion

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

40. U.S. Patent Application Publication 2004/0117197 by Dutta et al. June 17, 2004.
Discloses a transcoder which requests copyright permissions before transcoding.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David Lazaro
January 22, 2008